



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

26 September 2014*

(Community trade mark — Opposition proceedings — International registration of a trade mark designating the European Community — Figurative mark KW SURGICAL INSTRUMENTS — Earlier national word mark Ka We — Relative ground for refusal — Likelihood of confusion — Article 8(1)(b) of Regulation (EC) No 207/2009 — Appeal procedure — Scope of the examination to be carried out by the Board of Appeal — Proof of genuine use of the earlier mark — Application submitted to the Opposition Division — Refusal to register the trade mark applied for without prior examination of the condition of genuine use of the earlier trade mark — Error of law — Power to alter decisions)

In Case T-445/12,

Koscher + Würtz GmbH, established in Spaichingen (Germany), represented by P. Mes, C. Graf von der Groeben, G. Rother, J. Bühling, A. Verhauwen, J. Künzel, D. Jestaedt, M. Bergermann, J. Vogtmeier and A. Kramer, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Schifko, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM being

Kirchner & Wilhelm GmbH + Co., established in Asperg (Germany),

Action brought against the decision of the Fourth Board of Appeal of OHIM of 6 August 2012 (Case R 1675/2011-4), concerning opposition proceedings between Kirchner & Wilhelm GmbH + Co. and Koscher + Würtz GmbH,

THE GENERAL COURT (Second Chamber),

composed of M.E. Martins Ribeiro, President, S. Gervasoni (Rapporteur) and L. Madise, Judges,

Registrar: C. Heeren, Administrator,

having regard to the application lodged at the Registry of the General Court on 8 October 2012,

having regard to the response lodged at the Registry of the General Court on 23 January 2013,

* Language of the case: German.

having regard to the reply lodged at the Registry of the General Court on 2 May 2013,
having regard to the rejoinder lodged at the Registry of the General Court on 12 July 2013,
having regard to the amendment of the composition of the chambers of the General Court,
further to the hearing on 29 April 2014,
gives the following

Judgment

Background to the dispute

- 1 On 25 April 2008, the applicant, Koscher + Würtz GmbH, obtained from the International Bureau of the World Intellectual Property Organisation (WIPO) an international registration designating the European Community for the following figurative sign:



- 2 On 31 July 2008, the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) received notification of the international registration of that sign.
- 3 The goods in respect of which registration was applied for are in Class 10 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond to the following description: 'Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials'.
- 4 On 8 May 2009, Kirchner & Wilhelm GmbH + Co. ('the opposing party') filed a notice of opposition under Article 41 of Council Regulation (EC) No 207/2009, of 26 February 2009, on the Community trade mark (OJ 2009, L 78, p. 1) to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.
- 5 The opposition was based on the earlier national word mark Ka We, filed on 19 April 1930 and registered in Germany on 25 November 1930 under number 426260, designating the following goods falling within Class 10: 'Medical and sanitary instruments and apparatus, hearing aids, hygienic bandages, artificial limbs (with the exception of goods made out of or associated with rubber)'.

- 6 The grounds of the opposition were those laid down in Article 8(1)(b) of Regulation No 207/2009, on the basis that there was a likelihood of confusion between the mark applied for and the earlier mark.
- 7 On 23 June 2011, the Opposition Division rejected the opposition on the ground that there was no likelihood of confusion between the marks at issue.
- 8 On 16 August 2011, the opposing party filed a notice of appeal with OHIM, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the Opposition Division's decision.
- 9 By a decision of 6 August 2012 ('the contested decision'), the Fourth Board of Appeal of OHIM annulled the Opposition Division's decision and refused to grant the applicant protection of the international registration for the European Community.
- 10 By way of introductory observation, the Board of Appeal noted that the relevant public was the German public and that it was a professional public with expertise in the medical field (paragraphs 13 and 14 of the contested decision).
- 11 The Board of Appeal found, as had the Opposition Division, that the goods covered by the mark applied for and the goods covered by the earlier mark were identical (paragraph 15 of the contested decision).
- 12 When comparing the signs, the Board of Appeal noted that the earlier mark and the mark applied for contained an identical element, being the letters 'k' and 'w', which were the dominant and most distinctive part of the mark applied for and were also the two initial letters of the earlier mark Ka We. The Board of Appeal therefore found that there was a visual similarity, albeit to a low degree, between the two marks. The Board of Appeal also stated that a German speaker would pronounce the verbal element 'kw' and the mark Ka We identically and that, depending on whether or not the descriptive part in English of the mark applied for (that is, 'surgical instruments') was pronounced, the marks would be aurally identical or highly similar. The Board specified that a conceptual comparison was not relevant (paragraphs 16 to 18 of the contested decision).
- 13 With particular regard to the foregoing, and to the fact that orders for the goods covered by the earlier mark would also be placed by telephone, which made an aural comparison of the marks more relevant, the Board of Appeal concluded that there was a likelihood of confusion (paragraphs 19 and 20 of the contested decision).

Forms of order sought

- 14 The applicant claims that the Court should:
- annul the contested decision;
 - order OHIM to pay the costs, including the costs incurred in the proceedings before the Board of Appeal and before the Opposition Division.
- 15 In addition, the applicant states as follows at paragraph 50 of the application:
- 'The action is well founded. Given that there is no likelihood of confusion between the signs at issue, the opposition should be rejected. The Board of Appeal's decision should therefore be annulled.'
- 16 OHIM contends that the Court should:
- dismiss the action;

— order the applicant to pay the costs.

- 17 During the hearing, when questioned on the object of the action and, in particular, on the scope of paragraph 50 of its application, the applicant specified that it was seeking not only annulment of the contested decision but also an amendment of the decision to the extent that the General Court's powers allow it to dismiss the opposition.

Law

The scope of the forms of order sought by the applicant

- 18 Bearing in mind the way in which the application is formulated, in particular paragraph 50, and the clarifications given by the applicant at the hearing, the applicant should be regarded as seeking both annulment and amendment of a decision.
- 19 In support of the forms of order sought, the applicant raises two pleas in law, the first alleging an error of law on the part of the Board of Appeal in relation to Article 42(2) of Regulation No 207/2009, by allowing the opposition without examining whether the earlier mark had been put to genuine use, and the second claiming that there was no likelihood of confusion.

First plea: no examination by the Board of Appeal of genuine use of the earlier mark

- 20 The applicant, referring to Article 42(2) of Regulation No 207/2009, states that, even though it had raised the question of genuine use of the earlier mark during the opposition proceedings, the Board of Appeal did not rule on this question in the contested decision.
- 21 According to OHIM, this plea is inadmissible. OHIM considers the question of genuine use of the earlier mark to be extraneous to the object of the proceedings. In addition, the applicant only refers in a very general manner to observations made in the context of the administrative procedure, even though the language used before OHIM was a different one from the language of the case before the General Court, and does not allege any breach of Article 42(2) of Regulation No 207/2009 in its application. The question of a breach was only raised in the reply, which infringes Article 44(1) of the Rules of Procedure of the General Court.

Admissibility of the plea

- 22 It should be recalled that, under Article 44(1) of the Rules of Procedure, which applies to intellectual property by virtue of Article 130(1) and Article 132(1) thereof, an application must give a summary of the pleas in law on which it is based. It is settled case-law that although specific points in the text of the application can be supported and completed by references to specific passages in the documents attached, a general reference to other documents cannot compensate for the failure to set out the essential elements of the legal argument which must, under those provisions, appear in the application itself (Joined Cases T-350/04 to T-352/04 *Bitburger Brauerei v OHIM - Anheuser-Busch (BUD, American Bud and Anheuser Busch Bud)* [2006] ECR II-4255, paragraph 33).
- 23 In that regard, it should be noted that, in support of the plea alleging that the Board of Appeal failed to examine genuine use of the earlier mark, the applicant makes express reference in its application to Article 42(2) of Regulation No 207/2009, under which the party applying for the Community trade mark in question may request the opposing party to furnish proof that the earlier Community trade mark has been put to genuine use. The applicant states also that it raised this issue in the context of

the opposition proceedings, in a statement of 14 March 2011. Finally, the applicant adds that the Opposition Division was able to leave open the question of genuine use of the earlier mark to the extent that it found there was no likelihood of confusion between the marks at issue.

- 24 Consequently, the essential elements of the applicant's arguments appear in its application.
- 25 The fact that the documents to which the applicant refers are drafted in a language different from that of the proceedings before the General Court is irrelevant to the conclusion reached in the preceding paragraph.
- 26 As a result, contrary to OHIM's submission, the first plea is admissible.

Substance of the plea

- 27 Under Article 42(2) and Article 15(1) of Regulation No 207/2009, opposition to registration of a Community trade mark shall be rejected if the proprietor of the earlier trade mark at issue does not furnish proof that the earlier mark has been put to genuine use by its proprietor during the period of five years preceding the date of publication of the Community trade mark application. However, if the proprietor of the earlier trade mark successfully furnishes that proof, OHIM will examine the grounds for refusal advanced by the opposing party.
- 28 In addition, Article 64(1) of Regulation No 207/2009 provides that the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. It follows from that provision and from the scheme of Regulation No 207/2009 that, in ruling on an appeal, the Board of Appeal has the same powers as the department which was responsible for the decision appealed and that its examination concerns the dispute as a whole as it stands on the date of its ruling. It is apparent also from that provision, as well as from settled case-law, that there is continuity in terms of their functions between the different units of OHIM, namely the examiner, the Opposition Division, the division responsible for the administration of trade marks and legal issues and the Cancellation Divisions on the one hand, and the Boards of Appeal on the other. It follows from that continuity in terms of their functions between the different departments of OHIM that, in the context of the review which the Boards of Appeal must undertake of the decisions taken by the OHIM units which heard the application at first instance, the Boards are required to base their decisions on all the matters of fact and of law which the parties put forward, either in the proceedings before the department which heard the application at first instance or in the appeal (see Case T-323/03 *La Baronnia de Turis v OHIM - Baron Philippe de Rothschild (LA BARONNIE)* [2006] ECR II-2085, paragraphs 56 to 58 and the case-law cited).
- 29 The General Court has already held that the extent of the examination which the Board of Appeal of OHIM was required to conduct with regard to the decision under appeal, in that instance being the Opposition Division's decision, did not depend upon whether or not the party bringing the appeal had raised a specific ground of appeal with regard to that decision, criticising the interpretation or application of a provision by the department at OHIM which heard the application at first instance, or upon that department's assessment of a piece of evidence. Therefore, even if the party bringing the appeal before the Board of Appeal has not raised a specific plea, the Board of Appeal is none the less bound to examine whether or not, in the light of all the relevant matters of fact and of law, a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling. Consideration of whether, in the light of the facts and evidence put forward by the other party to the proceedings before the Board of Appeal, that party has furnished proof of genuine use, forms part of the examination that the Board of Appeal of OHIM must carry out in relation to the decision under appeal (Case T-203/02 *Sunrider v OHIM - Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 21).

- 30 It must be noted in this connection that the request for the opposing party to furnish proof of the genuine use of the earlier mark has the effect of shifting the burden of proof to the opposing party to demonstrate genuine use of his mark or face having his opposition dismissed. Genuine use of the earlier mark is therefore a matter which, once raised by the applicant for the trade mark, must be settled before a decision is given on the opposition proper. The request for proof of genuine use of the earlier mark therefore adds to the opposition procedure a specific and preliminary question and in that sense changes the content thereof (see, to that effect, Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 37).
- 31 The circumstances of the present case must therefore be examined in the light of the above case-law.
- 32 In this regard, it appears from the documents before the General Court that the applicant, in the context of the opposition proceedings, made a request under Article 42(2) of Regulation No 207/2009 but that neither the Opposition Division nor the Board of Appeal ruled on the question of genuine use of the earlier mark.
- 33 First, the file from the proceedings before the Board of Appeal shows that, in a statement of 10 September 2010, the applicant observed that the earlier mark had been registered since 1930 and therefore asked the opposing party, on the basis of Article 42(2) of Regulation No 207/2009, to supply proof of genuine use of that mark. The same file also shows that the applicant again queried an established genuine use of the earlier mark, in a statement of 14 March 2011. The Opposition Division's decision appearing in the file from the proceedings before the Board of Appeal states as follows: 'Given that the opposition is not well founded under Article 8(1) [of Regulation No 207/2009] it is unnecessary to examine the evidence of use filed by the opponent'. Finally, it appears from the contested decision that the Board of Appeal annulled the Opposition Division's decision and refused to grant the applicant Community protection for the international registration it had obtained, without ruling on the genuine use of the earlier mark.
- 34 In view of all the matters set out above, it must be concluded that the Board of Appeal made an error of law. Even though a request in relation to genuine use of the earlier mark had been made by the applicant before the Opposition Division, the Board of Appeal refused to grant the applicant Community protection for the international registration it had obtained, without first examining the question of genuine use of the earlier mark.
- 35 It should be added that the General Court may base its decision on information in the file from the proceedings before the Board of Appeal if the parties have referred to it in a sufficiently precise way.
- 36 As a result of the foregoing, the first plea in law must be upheld.
- 37 Consequently, the order sought by the applicant for annulment of the contested decision must be granted.
- 38 In addition, as stated above (paragraph 18), the applicant is also seeking an amendment of the decision.
- 39 In that respect, the first plea in law can only result in the contested decision being annulled and the case being referred back to the Board of Appeal. This is because, in its consideration of this plea, the General Court is not ruling on the likelihood of confusion between the conflicting marks. Furthermore, it should be recalled that the General Court's jurisdiction to amend decisions, conferred by Article 65(3) of Regulation No 207/2009, does not enable the General Court to review a question on which the Board of Appeal has not yet ruled. Exercise of the power to amend decisions must therefore, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (Case C-263/09 P *Edwin v OHIM*

[2011] ECR I-5853, paragraph 72). Therefore, in the present case, the General Court cannot carry out any assessment of genuine use of the earlier mark, since the Board of Appeal did not rule on that point.

40 By contrast, the second plea in law, relating to the absence of a likelihood of confusion, could, if held to be well founded, enable the applicant, to obtain disposal of the entire case, that is to say, if the opposition were to be dismissed. Moreover, it should be noted that the Board of Appeal did rule on the question of likelihood of confusion between the two marks at issue.

41 The General Court must therefore examine the second plea in law.

Second plea: no likelihood of confusion

42 It should be recalled that Article 8(1)(b) of Regulation No 207/2009 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the two trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. The likelihood of confusion includes the likelihood of association with the earlier trade mark. In addition, under Article 8(2)(a)(ii) of Regulation No 207/2009, the term 'earlier trade marks' means trade marks registered in a Member State with a date of application for registration which is earlier than the date of application for registration of the Community trade mark.

43 According to settled case-law, the risk that the public may believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. According to that same case-law, the likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and the goods or services concerned and account being taken of all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM - Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33 and the case-law cited).

Relevant public

44 According to the case-law, in the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see Case T-256/04 *Mundipharma v OHIM - Altana Pharma (RESPICUR)* [2007] ECR II-449, paragraph 42 and the case-law cited).

45 In the present case, the Board of Appeal observed at paragraph 13 of the contested decision, and this is not disputed before the General Court, that the likelihood of confusion must be analysed in relation to the German public, since the earlier mark was registered and protected in Germany. The Board of Appeal also stated, at paragraph 14 of the contested decision, and again this is not disputed before the General Court, that the goods covered by the conflicting marks were directed at a professional public with expertise in the medical field and that the level of attention of this public was particularly high.

Comparison of the goods

- 46 According to settled case-law, in order to assess the similarity of the goods or services concerned, all the relevant features of the relationship between those goods or services should be taken into account. Those factors include, inter alia, their nature, intended purpose and their method of use and whether the goods or services are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see Case T-443/05 *El Corte Inglés v OHIM - Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-2579, paragraph 37 and the case-law cited).
- 47 At paragraph 15 of the contested decision, the Board of Appeal held that the goods covered by the earlier mark were used for medical purposes and had the same purpose, nature and method of use as the goods covered by the earlier mark. The Board of Appeal therefore found that the goods at issue were identical.
- 48 The applicant disputes that finding. However, the applicant states only that the goods are not identical or similar, without being any more specific, and refers to a statement made in the context of the opposition proceedings. These arguments are insufficient, bearing in mind the information on the file, for it to be held that the goods at issue are not identical or, at the very least, similar.

Comparison of the signs

- 49 It is settled case-law that the overall assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression which they create, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the overall assessment of that likelihood of confusion. In that respect, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-597/12 P *Isdin v OHIM and Bial-Portela* [2013] ECR, paragraph 19).
- 50 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraph 42, and judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, not published in the ECR, paragraph 42). That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public keep in their minds, so that all the other components are negligible in the overall impression created by that mark (*Nestlé v OHIM*, paragraph 43).

– Visual similarity

- 51 On a visual comparison of the two marks, it should first be recalled that there is nothing preventing a determination as to whether there is any visual similarity between a word mark and a figurative mark, since the two types of mark have graphic form capable of creating a visual impression (see Case T-359/02 *Chum v OHIM - Star TV (STAR TV)* [2005] ECR II-1515, paragraph 43 and the case-law cited).

- 52 In the contested decision, the Board of Appeal found that the marks at issue exhibited a low degree of visual similarity. The Board of Appeal stated that, while only the mark applied for includes the words ‘surgical’ and ‘instruments’ and figurative elements, the two signs coincide in the letters ‘k’ and ‘w’ which form the dominant and most distinctive element of the mark applied for and which are the two initial letters of the earlier mark.
- 53 However, the applicant maintains that, in the context of an examination which must be an overall one, the two signs are not visually similar, bearing in mind the importance of the additional words ‘surgical’ and ‘instruments’ and the figurative elements which only appear on the mark applied for.
- 54 In that regard, it should be noted that the letters ‘k’ and ‘w’, which are the initial letters of the two words making up the earlier mark, are the dominant elements of the mark applied for owing to their size and the fact that they appear with a much thicker outline than the other elements of that mark. Furthermore, the element formed by the combination of those two letters has a more distinctive character than the other elements of the mark, that is to say, the additional words ‘surgical’ and ‘instruments’ and the figurative elements comprising a semicircle and the representation of a surgical instrument.
- 55 In view of the foregoing, it must be held that the Board of Appeal correctly found, on the basis of the overall impression conveyed by the two conflicting signs, that there was a low degree of similarity between them.
- 56 The fact that the mark applied for uses a different font for the letters ‘k’ and ‘w’ from that used in the earlier mark does not affect the conclusion reached in the previous paragraph, all the more so given that the earlier mark is a word mark and, consequently, is not distinguished by a particular font (see, to that effect, Case T-434/07 *Volvo Trademark v OHIM - Grebenshikova (SOLVO)* [2009] ECR II-4415, paragraph 37).
- Aural similarity
- 57 At paragraph 17 of the contested decision, the Board of Appeal held that the two conflicting signs were, depending on whether or not the additional words ‘surgical’ and ‘instruments’ were pronounced, aurally identical or highly similar.
- 58 The applicant submits that, aurally, the words ‘surgical’ and ‘instruments’ are not secondary to such an extent that they can be ignored and that they therefore introduce a clear distinction between the mark applied for and the earlier mark.
- 59 In that respect, it should be pointed out that a distinction such as the one mentioned in the preceding paragraph does not alter the identical nature of the beginning of the overall sound of the mark applied for and the overall sound of the earlier mark.
- 60 According to the case-law, the consumer generally pays greater attention to the beginning of a mark than to the end (Case T-133/05 *Merix v OHIM - Arbora & Ausonia (PAM-PIM’S BABY-PROP)* [2006] ECR II-2737, paragraph 51).
- 61 It must therefore be held that the conflicting marks are, aurally, highly similar, and indeed identical if the relevant public only pronounces the abbreviated form of the mark applied for, omitting the words ‘surgical’ and ‘instruments’.

62 It should be noted that the applicant's argument that the relevant public, made up of specialists, will know that the verbal element 'kw' of the mark applied for represents the initials of the names Koscher and Würtz and will pronounce it accordingly, is pure supposition. Moreover, pronouncing it in this way does not decrease the likelihood of confusion between the conflicting marks since it could just as well refer to the names Kirchner and Wilhelm as to the names Koscher and Würtz.

63 The Board of Appeal was therefore correct to conclude that, in terms of the overall impression conveyed by the two conflicting marks, the two were aurally identical or highly similar.

– Conceptual similarity

64 The applicant rightly maintains that the words 'surgical' and 'instruments', which only appear in the mark applied for, will have a meaning for a section of the relevant public. Therefore, the Board of Appeal was wrong to hold, at paragraph 18 of the contested decision, that the two signs at issue had no meaning.

65 However, it should be noted that, if the words 'surgical' and 'instruments' were taken into account when analysing conceptual similarity, then, as the Board of Appeal correctly stated in paragraph 18 of the contested decision, they would simply be understood by the English-speaking public in Germany as referring to medical apparatus used in surgery. Taking those additional words into account therefore does nothing to dispel the likelihood of confusion.

66 In an overall analysis of the likelihood of confusion, it is necessary to examine whether the presence of the conceptual element 'surgical instruments' could affect the Board of Appeal's conclusion that there was a likelihood of confusion between the two marks at issue.

Likelihood of confusion

67 The overall assessment of the likelihood of confusion implies some interdependence between the factors taken into account, and in particular between the similarity of the marks and the similarity of the goods or services concerned. Accordingly, a low degree of similarity between the goods or services may be offset by a high degree of similarity between the marks, and vice versa (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 17, and Joined Cases T-81/03, T-82/03 and T-103/03 *Mast-Jägermeister v OHIM - Licorera Zacapaneca (VENADO with frame and Others)* [2006] ECR II-5409, paragraph 74).

68 By way of preliminary observation, it should be noted that the Board of Appeal stated in paragraph 19 of the contested decision that the distinctiveness of the earlier mark was average.

69 In that regard, it should be recalled that a finding that the earlier mark has a weak distinctive character does not prevent a finding that there is a likelihood of confusion (see, to that effect, order of 27 April 2006 in Case C-235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraphs 42 to 45). Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in such assessment. Accordingly, there may be a likelihood of confusion even where an earlier mark has a weak distinctive character, especially where the signs at issue, and the goods or services in question, are similar (see Case T-112/03 *L'Oréal v OHIM - Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61, and Case T-134/06 *Xentral v OHIM - Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70 and the case-law cited).

70 Next, it should be recalled that Article 8(1)(b) of Regulation No 207/2009 provides that the trade mark applied for shall not be registered if there exists a 'likelihood' of confusion.

- 71 In the present case, it is true that the words ‘surgical’ and ‘instruments’ and the figurative elements composed of a semicircle and the representation of a surgical instrument appear only in the mark applied for.
- 72 However, if account is taken firstly of the presence of the letters ‘k’ and ‘w’ in each of the marks at issue, secondly, of the fact that those letters, which are the initial letters of the two words making up the earlier mark, constitute the dominant and most distinctive part of the mark applied for from a visual perspective and, thirdly, of the identical pronunciation in German of the mark Ka We and the verbal element ‘kw’, the differences stated in the preceding paragraph are not sufficient to prevent the relevant consumer from forming the impression that those marks, when assessed globally, have a low degree of similarity visually and are identical or highly similar aurally (see, to that effect, Case T-460/07 *Nokia v OHIM - Medion (LIFE BLOG)* [2010] ECR II-89, paragraphs 54 and 56 and the case-law cited).
- 73 It should be added that the presence in the mark applied for of the verbal element ‘surgical instruments’ is not, in any event, such as to counteract the visual and aural similarities between the two marks at issue noted in the preceding paragraph (see, to that effect, Case C-206/04 P *Mühlhens v OHIM* [2006] ECR I-2717, paragraph 36).
- 74 Finally, on the assumption that an identity is established between the goods covered by the two conflicting marks, the degree of similarity which, at the very least, exists between them when the goods covered by the earlier mark are taken into account globally, is sufficient to indicate a likelihood of confusion.
- 75 Thus, contrary to the applicant’s submission, the Board of Appeal is not found to have committed an error in holding that there was a likelihood of confusion between the two marks at issue.
- 76 The foregoing conclusion is not affected by the arguments raised by the applicant.
- 77 Firstly, even on the assumption that the earlier mark was registered as a combination of two words, ‘ka’ and ‘we’, this does not mean that there is no likelihood of confusion.
- 78 Secondly, the applicant has not proven that the fact that the goods covered by the conflicting marks are directed at a professional public with expertise in the medical field, that the level of attention of that public is particularly high and that there is only a limited number of suppliers of the goods at issue, means that there is no likelihood of confusion.
- 79 Thirdly, in relation to the applicant’s contention that it is only in exceptional cases that the goods at issue will only be offered, marketed or promoted by telephone, this is not supported by any evidence and is therefore not proven.
- 80 In addition, even on the assumption that such a contention could be proven, not only in respect of the mark applied for but also the earlier mark, this would not mean there was no likelihood of confusion, since, from an aural perspective, use of the sign is not limited to situations where the goods at issue are being marketed, but also to other situations where the professionals in question make oral reference to those goods, for example when using them or discussing their use and, in particular, when referring to the benefits and drawbacks of those goods.
- 81 In that respect, even though the Court of Justice has held that the authority called upon to assess whether there is a likelihood of confusion cannot reasonably be required to establish, for each category of goods, the consumer’s average amount of attention on the basis of the level of attention which he is capable of displaying in different situations or to take into account of the lowest degree of attention which the public is capable of displaying when faced with a product and a mark (see Case

C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643, paragraphs 42 and 43), the Court has not excluded the possibility of situations other than the purchase itself being taken into account when assessing the existence of a likelihood of confusion.

- 82 As a result of the foregoing, the second plea in law must be dismissed and the order sought by the applicant for amendment of a decision must be rejected.
- 83 It should be specified that, following examination of the genuine use of the earlier mark as a result of this judgment, it will be for OHIM to make a new decision, if applicable, on the likelihood of confusion between the two conflicting marks. It will thus be for OHIM, when comparing the two marks, to draw the consequences of a potential lack of genuine use of the earlier mark for some of the goods covered.

Costs

- 84 Pursuant to Article 136(2) of the Rules of Procedure, only costs necessarily incurred by the parties for the purposes of proceedings before the Board of Appeal are regarded as recoverable costs. Therefore, the applicant's claim is inadmissible in so far as it relates to the costs arising from the administrative proceedings before the Opposition Division, which do not constitute recoverable costs.
- 85 As for the costs relating to proceedings before the Board of Appeal and those relating to proceedings before the General Court, it should be recalled that, under Article 87(3) of the Rules of Procedure, where each party succeeds on some and fails on other heads, the General Court may order that the costs be shared or that each party bear its own costs.
- 86 In the present case, OHIM should bear its own costs and pay half of the costs incurred by the applicant in the proceedings before the Board of Appeal and before the General Court.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

- 1. Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 6 August 2012 (Case R 1675/2011-4), concerning opposition proceedings between Kirchner & Wilhelm GmbH + Co. and Koscher + Würtz GmbH;**
- 2. Dismisses the action as to the remainder;**
- 3. Orders OHIM to bear its own costs and to pay half of the costs incurred by Koscher + Würtz in the proceedings before the Board of Appeal and the General Court;**
- 4. Orders Koscher + Würtz to bear half of the costs it has incurred in the proceedings before the Board of Appeal and the General Court.**

Martins Ribeiro

Gervasoni

Madise

Delivered in open court in Luxembourg on 26 September 2014.

[Signatures]